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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/461,375 | 12/15/1999 | JEAN-LOUIS GUERET | 2350-76 | 3736 |

7590

09/24/2003

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| EXAMINER |
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CHOI, FRANK I

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| ART UNIT | PAPER NUMBER |
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1616

DATE MAILED: 09/24/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/461,375

Applicant(s)

GUERET, JEAN-LOUIS

Examin r

Frank I Choi

Art Unit

1616

-- The MAILING DATE f this communication appears on the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/27/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ^{4,5,7-}~~2-27~~ is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) ^{4,5,7-}~~2-9, 15 and 17-27~~ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) ^{4,5,7-}~~2-26~~ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges the written request for an interview, however, at the time the case was taken up for prosecution Examiner was required to act on the case and there was no time to grant an interview. In light of the above, Examiner will grant an after-final interview, either by telephone or in person, and requests that Applicant's attorney or agent contact Examiner to set-up the same.

Election/Restrictions

This application contains claims 10-14, 16 drawn to an invention nonelected with traverse in Paper No. 5. New claim 27 appears to be directed to the elected invention and will be prosecuted accordingly. Claims ^{4,5,7-}~~2~~-27 are currently pending with claims 10-14, 16 withdrawn from prosecution as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 27 excludes tackifying resin, however, no where in the Specification is the limitation

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"tackifying resin" disclosed. The mere fact that the hydrophobic polymers have adhesive properties does not support the claim limitation in claim 27 excluding tackifying resins. The adhesive art contemplates the use tackifiers even where the polymer compositions already are sufficiently adhesive. See Wick et al. (US Pat. 5, 238,944) at Column 7, lines 18-23 (indicating that the polymer compositions are inherently adhesive but tackifiers can be added if desired).

^{4,5,7-}
Claims 2-9, 15, 17-27 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that said claims fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 5 filed 11/6/00 and Paper No. 17 (10/27/2003). In paper no. 5, applicant has stated the compositions contain no water and then in paper no. 17 modified it to substantially no water, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not clearly indicate that they may not contain substantial amounts water. Examiner as duly considered Applicant's arguments but deems them unpersuasive.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 190 USPQ 461, 463 (CCPA 1976). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 143 USPQ 256 (CCPA 1964). MPEP Section 2111.03. Applicant does not appear to have met its burden of showing that addition of substantial amounts of water would materially change the characteristics of its invention. In the first instance, Applicant has

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made no showing as to what constitutes "substantial" amounts of water or that the Specification supports the implicit incorporation of said limitation into the claims. Further, the fact that the claim recites "solution" does not support Applicant's argument that substantial amounts of water are excluded. The Specification clearly indicates that water-absorbable and water-soluble components can be part of the claimed invention, that the claimed invention can be a dispersion and contemplates the addition of water (i.e. hydration) (Pg. 4, lines 28,29, 33-34, Pg. 5, lines 13-27). As such, the rejection herein is maintained.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 was amended to include between 20 to 60% by weight of the hydrophobic polymer and 0.1 to 20% by weight of the filler and/or essential oil. Claim 5 requires between 20% and 80% by weight of the solvent, which renders the claim indefinite as the maximum amount of organic solvent will result in the claim having more than 100% by weight of the solution.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

~~4/5, 7-~~

Claims ~~2-9~~, 15, 17-22, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higo et al. (WO 96/16642) for the reasons of record set forth in the prior Office Actions and the further reasons below.

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Higo et al. was discussed in the prior Office Actions and the same is incorporated herein.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant argues that the tackifying resin are excluded by the recitation "consisting essentially of". However, as indicated above, the burden is on Applicant to show that the introduction of additional steps or components would materially change the characteristics of applicant's invention; which Applicant does not appear to have met its burden. The mere fact that the hydrophobic polymers are adhesive does not support the conclusion that tackifying resins are implicitly excluded in the claimed invention. The adhesive art contemplates the use tackifiers even where the polymer compositions already are sufficiently adhesive. See Wick et al. (US Pat. 5, 238,944) at Column 7, lines 18-23 (indicating that the polymer compositions are inherently adhesive but tackifiers can be added if desired).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion


A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

September 18, 2003



JOHN PAK
PRIMARY EXAMINER
GROUP 1600